

### **REMARKS**

In the Final Office Action of April 8, 2004, claims 1-9, 35-36 and 38-40 were rejected under 35 U.S.C. 112, second paragraph, claims 1-5, 35-36 and 38-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,179,866 to Graham et al. ("Graham") in view of Official Notice taken by the Examiner, claims 1-5, 35-36 and 38-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of U.S. Patent 5,044,143 to Ako et al. ("Ako"), claims 1 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,115,625 to Barbulesco et al. ("Barbulesco") in view of Official Notice taken by the Examiner, claims 6-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of U.S. Patent 4,550,549 to Reinfeld et al. ("Reinfeld"), and claims 6-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of Ako in further view of Reinfeld.

In response to the Final Office Action, Applicants amend independent claims 1 and 35 to overcome the indefiniteness rejections and to incorporate all of the limitations of claim 2 and claim 36, respectively. Applicants also amend claims 3, 39 and 40 to depend on claim 1 and claim 38 to depend on claim 35. No new matter has been added by any of the amendments and the amendments have not substantively modified the scope of the claims. Consequently, a new search should not be necessitated by the amendments. Accordingly, Applicants respectfully request that the Examiner enter the amendments.

Applicants offer the following arguments in favor of allowance. Reconsideration and withdrawal of the rejections is respectfully requested.

#### **35 U.S.C. 112, Second Paragraph, Rejections.**

In the Final Office Action, claims 1-9, 35-36 and 38-40 were rejected under 35 U.S.C. 112, second paragraph, for being indefinite. The Examiner suggested that a more clear limitation would be to define an axis of movement.

In response to this indefiniteness rejection, Applicants have amended independent claims 1 and 35 to define an axis of movement. Independent claim 1 now recites, "an elevator lift apparatus operatively connected below the box erecting apparatus, the elevator lift apparatus

having a third position, a fourth position and an axis of movement such that when the elevator lift apparatus lifts the at least one good from the third position to the fourth position, the at least one good passes through the bottom opening, into the box, and between the first device and the second device in the second position.” Similarly, independent claim 35 now recites, “activating an elevator lift apparatus to raise an at least one good from a first position up to a second position within the box, the elevator lift apparatus having an axis of movement such that when the elevator lift apparatus lifts the at least one good from the first position to the second position, the at least one good passes through the bottom opening, into the box, and between the second device and the first device in the displaced position.”

Applicants respectfully submit that independent claims 1 and 35 and their respective dependent claims are no longer indefinite. Reconsideration and withdrawal of the indefiniteness rejections is respectfully requested.

35 U.S.C. 103(a) Rejections.

In order for a combination of references to establish a case of prima facie obviousness, three requirements must be met:

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art references when combined must teach or suggest all the claim limitations.

*MPEP §2142.*

**a. Graham in view of Official Notice**

In the Final Office Action, claims 1-5, 35-36 and 38-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of Official Notice taken by the Examiner. Specifically, the Examiner took “OFFICIAL NOTICE that it would have been obvious to one of

ordinary skill in the art to position the opening devices along conveyer 26 in order to maintain the container in the open position.” *Final Office Action*, p. 3, ll. 13-15.

Applicants respectfully assert that the Examiner has failed to establish a prima facie case of obviousness for the following reasons: (1) the facts noticed by the Examiner are not of a notorious character and, as a result are not appropriate for Official Notice; (2) even if the facts were appropriate for Official Notice, modifying Graham “to position opening devices along the conveyor 26 in order to maintain the container in the open position,” as proposed by the Examiner, still fails to teach or suggest all of the limitations of independent claims 1 and 35; and (3) it would not be obvious to modify Graham to provide the unaddressed limitations of independent claims 1 and 35 because Graham teaches against doing so.

Applicants respectfully traverse the Examiner’s position. “While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection.” MPEP 2144.03. Furthermore, official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known ... are capable of instant and unquestionable demonstration as being well-known.” *Id.* More specifically, “the notice of facts beyond the record ... must be capable of such instant and unquestionable demonstration as to defy dispute.” *Id.* “[T]he facts so noticed [must be] of notorious character” and “serve only to fill in the gaps in an insubstantial manner.” *Id.*

Examples of when facts were sufficiently “notorious” to take judicial notice include taking judicial notice that (1) “it is old to adjust intensity of a flame in accordance with the heat requirement” and (2) “tape recorders commonly erase tape automatically when new audio information is recorded on a tape which already has a recording on it.” *Id.*

**The facts noticed by the Examiner are not of a notorious character and, as a result, it is improper for the Examiner to take Official Notice of such facts.** For example, “[e]ach erected case 11 moving along the case conveying means 25 is gripped along its side walls 12 by opposed endless belts 26 .... The belts 26 are conventionally entrained about support pulleys 27 on a framework 10.” *Graham*, col. 4, ll. 2-6. Graham does not teach a need for the modification suggested by the Examiner and, furthermore, it is unclear at best how an opening device could be

positioned along the conveyor 26 in order to maintain the containers in the open position, as alluded to by the Examiner, when the belts 26 are moving and each case has top flaps that need to be folded shut and bottom flaps that need to be folded outwards prior to receiving the contents to be loaded into the case by the elevator.

**Even if the aforementioned facts were properly noticed by the Examiner, Graham as modified by the Examiner still fails to teach or suggest each and every limitation of independent claims 1 and 35.** For example, Applicants' independent claim 1 recites, "a box erecting apparatus ... comprising a first device adapted to contact the first sidewall and a second device adapted to contact the second sidewall, wherein the second device is displaceable from a first position, which is adjacent to the first device, to a second position, thereby unfolding the box." Independent claim 1 then goes on to recite, "an elevator lift apparatus operatively connected below the box erecting apparatus [and] ... having ... an axis of movement such that when the elevator lift apparatus lifts the at least one good ..., the at least one good passes through the bottom opening, into the box, and between the first device and the second device in the second position."

In a similar fashion, Applicants' independent claim 35 recites, "(a) presenting the first sidewall to a first device as the box is in a flat-folded configuration and the second sidewall is attached to a second device; (b) attaching the first device to the first sidewall; (c) unfolding the box by moving the first device to a displaced position away from the second device." Independent claim 35 then goes on to recite, "(d) activating an elevator lift apparatus to raise an at least one good from a first position up to a second position within the box, the elevator lift apparatus having an axis of movement such that when the elevator lift apparatus lifts the at least one good from the first position to the second position, the at least one good passes through the bottom opening, into the box, and between the second device and the first device in the displaced position."

Thus, even if it were instantly and unquestionably well-known to modify Graham, as suggested by the Examiner, by "position[ing] the opening devices along conveyor 26 to maintain the containers in the open position," Applicants' invention as recited in independent claims 1 and 35 do more than merely maintain the containers in an open position. For example, the box

erecting apparatus of Applicants' claimed invention has devices that "unfold[] the box by moving the first device to a displaced position away from the second device." The elevator lift apparatus of Applicants' claimed invention, which is "operatively connected below the box erecting apparatus," has "an axis of movement such that when the elevator lift apparatus lifts the at least one good ..., the at least one good passes through the bottom opening, into the box, and between the first device and the second device in the second position." Clearly, at least these features of Applicants' invention as recited in independent claims 1 and 35 are not taught or suggested by Graham as modified by the Examiner.

**Graham clearly teaches away from being modified to have a box opening device positioned above the elevator apparatus such that the axis of movement for the elevator causes the good to pass between the first and second devices of the box erecting apparatus when the second device is in a position displaced from the first device.** For example, as best understood by referring to Figs. 3, 4, 8 and 10 of Graham,

[e]ach incoming erect case 11 is contacted by front and rear flap engaging means indicated generally by the reference numeral 45. The front and rear flap engaging means as illustrated comprises a flap folding element 37 that folds the front and rear flaps 17, 18 outward in readiness for the packing procedures; ....

The flap folding element 37 engages the front flap 17 while each case 11 is at the ready station 7. FIG. 3 shows element 37 in its raised or upper position, with its upper surface 40 in contact with the forwardly protruding flap 17. The flap 17 is folded forward of the case as the element 37 is raised upward to engage it. Each flap 17 is first contacted by the upright 38, which pushes the flap 17 forward and upward from its normal vertical position. The rearwardly facing edge 41 across the flap folding element 37 subsequently folds the rear flap 18 to a similar horizontal position **as it is traversed by the case 11 during movement of the case between the ready station 7 and the packing station 8.**

The rear flap engaging element 44 has a transverse plow 51 fixed to it. As shown in FIG. 3 and FIG. 7, **this plow 51 spreads the lower side flaps 16 as**

**each case 11 approaches the packing station 8.** Thus, the flaps 16, 17 and 18 are spread outward from the vertical walls of the case to facilitate entry of a load into the case through its open bottom end.

*Graham, col. 4 ll. 13-59.*

Thus, it is clear that Graham requires an erected box to transverse the features of the flap engaging means 45 to cause the flaps to spread outwardly to allow the elevator to insert the load into the box. Therefore, erecting the box directly over the Graham elevator and not causing the erected box to travel along the endless belts 26 would prevent the flaps of an erected box from properly engaging the features of the flap engaging means 45 and opening. As a result, the box flaps would prevent the load from entering the box and Graham would become an inoperable device.

**Applicants' invention as recited in independent claims 1 and 35 is advantageous over the cited art.** This is because, as stated in the Background section of Applicants' specification, for some prior art packaging systems, "[a]ll of the equipment to unfold a cardboard box container, package it with goods, and seal it can exceed 34 feet in length." *Applicants' Spec. as filed, p. 1, ll. 22-23.* In contrast, Applicants' claimed invention is able to have a footprint that is "approximately four feet by five feet." *Applicants' Spec. as filed, p. 5, ll. 16-17.* This significantly smaller footprint is partly the result of Applicants' "elevator lift apparatus [being] operatively connected below the box erecting apparatus [and] ... having ... an axis of movement such that when the elevator lift apparatus lifts the at least one good from the third position to the fourth position, the at least one good passes through the bottom opening, into the box, and between the first device and the second device in the second position." *Applicants' independent claim 1.*

In summary, Applicants respectfully assert that the Examiner has failed to establish a prima facie case of obviousness for several reasons. First, the facts noticed by the Examiner are not of a notorious character and, as a result are not appropriate for Official Notice. Second, even if the facts were appropriate for Official Notice, modifying Graham as proposed by the Examiner still fails to teach or suggest all of the limitations of Applicants' independent claims 1 and 35.

Third, it would not be obvious to modify Graham to provide the unaddressed limitations of independent claims 1 and 35 because Graham teaches against doing so. These arguments apply equally to the claims that are dependent on independent claims 1 and 35. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the obviousness rejections based on Graham as modified by Official Notice.

**b. Graham in view of Ako**

In the Final Office Action, claims 1-5, 35-36 and 38-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of Ako.

Applicants respectfully assert that the Examiner has failed to establish a prima facie case of obviousness because (1) neither Graham nor Ako teaches or suggests all of the limitations of independent claims 1 and 35, and (2) it would not be obvious to modify Graham to provide the unaddressed limitations of independent claims 1 and 35 because Graham teaches against doing so.

In an attempt to support his obviousness rejection based on the Graham/Ako combination, the Examiner asserts that Ako “disclose[s] opening containers by opposing suction opening devices 41; see figure 5a.” *Final Office Action*, p. 3, ll. 19-20. Applicants respectfully submit that the Examiner has misinterpreted the function of “devices 41” in Ako. For example, Ako discloses a system where,

[a]s shown in FIGS. 3B and 4A-4B, many folded sheets of cartons 4a ... are drawn from magazine 30 one by one using vacuum pads 31 which move reciprocally. At the same time, using guides 32, 33 and guide rail 34, a flat carton sheet is [] assembled to a square box and then it [is] guided to carton loading unit 16 which is located next to assembler 15.

The loading mechanism consist of the drives (refer to FIGS. 5A and 5B) for feeding assembled carton 4 to the left and a slider (refer to FIG. 5C). Several driving units are located at both sides of said slider as explained below. Namely, as shown in FIG. 5A, driving units (refer the numerals of 41, 42) are located at

both sides of loading mechanism 16 and pull forward or push the carton 4 from behind, by using vacuum pads.

*Ako, col. 5, ll. 63-68; col. 6, ll. 1-2, 39-46.* In other words, Ako assembles cartons 4 at the assembler 15 via vacuum pads 31 and guides 32, 33. Ako then guides the assembled boxes from the assembler 15 to the carton loading unit 16 via driving units 41, 42. Thus, contrary to the Examiner's assertion in the Office Action, Ako's driving units 41 are not opening devices.

As a result, Ako does not teach or disclose an invention, as recited in Applicants' independent claims 1 and 35, where a box is unfolded "by moving the first device to a displaced position away from the second device," and an elevator lift apparatus, which is "operatively connected below the box erecting apparatus," has "an axis of movement such that when the elevator lift apparatus lifts the at least one good ..., the at least one good passes through the bottom opening, into the box, and between the first device and the second device in the second position."

As explained in the preceding section, Graham not only fails to teach these recited features of Applicants' claimed invention, but Graham clearly teaches away from being modified to have a box opening device positioned above the elevator apparatus such that the axis of movement for the elevator causes the good to pass between the first and second devices of the box erecting apparatus when the second device is in a position displaced from the first device. For at least this reason, the Graham/Ako combination fails to teach or disclose each and every element of Applicants' invention as recited in independent claims 1 and 35 and their respective dependent claims. Applicants respectfully request reconsideration and withdrawal of the obviousness rejections based on the Graham/Ako combination.

**c. Barbulesco in view of Official Notice**

In the Final Office Action, claims 1 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Barbulesco in view of Official Notice taken by the Examiner. Specifically, the Examiner took "OFFICIAL NOTICE that it would have been obvious to one of ordinary skill in the art to substitute a pivoting member contacting the opposing sidewall of the container in order to open the container." *Final Office Action, p. 4, ll. 6-9.*

Applicants respectfully assert that the facts noticed by the Examiner do not rise to the level of “notorious character” and, as a result are not appropriate for Official Notice.

Furthermore, **Applicants respectfully assert that Barbulesco, as modified by the Examiner, fails to teach or suggest each and every limitation recited in Applicants’ independent claims 1 and 35 as now amended.**

Applicants have amended independent claim 1 to incorporate all of the features of claim 2, which was dependant on claim 1 and was not rejected by the Examiner as being unpatentable over Barbulesco. Specifically, independent claim 1 now recites, “a support mechanism operably positioned relative to the box erecting apparatus wherein the support mechanism directly contacts and receives the at least one good after the elevator lifts the at least one good to the fourth position, the support mechanism supporting the at least one good substantially over the top of the elevator lift apparatus as the elevator lift apparatus returns to the third position to then receive another good to be moved to the fourth position.”

Similarly, Applicants have amended independent claim 35 to incorporate all of the features of claim 36, which was dependant on claim 35 and was not rejected by the Examiner as being unpatentable over Barbulesco. Specifically, independent claim 35 now recites, “supporting the at least one good via direct contact between a support member and the at least one good in a position substantially over the top of the elevator lift apparatus while the elevator lift apparatus returns to the first position to then receive at least another good to be moved to the second position.”

Barbulesco does not teach or suggest these aspects of Applicants’ invention as recited in independent claims 1 and 35 as now amended. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the obviousness rejections based on Barbulesco.

**d. Graham in view of Reinfeld**

In the Final Office Action, claims 6-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of Reinfeld.

As explained in the preceding sections, Graham clearly teaches away from being modified to have a box opening device positioned above the elevator apparatus such that the axis of movement for the elevator causes the good to pass between the first and second devices of the box erecting apparatus when the second device is in a position displaced from the first device. Reinfeld does not remedy this deficiency. For at least this reason, the Graham/Reinfeld combination fails to teach or disclose each and every element of Applicants' invention as recited in independent claims 1 and 35 and their respective dependent claims. Applicants respectfully request reconsideration and withdrawal of the obviousness rejections based on the Graham/Reinfeld combination.

**d. Graham in view of Ako in further view of Reinfeld**

In the Final Office Action, claims 6-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Graham in view of Ako in further view of Reinfeld.

As explained in the preceding sections, Graham clearly teaches away from being modified to have a box opening device positioned above the elevator apparatus such that the axis of movement for the elevator causes the good to pass between the first and second devices of the box erecting apparatus when the second device is in a position displaced from the first device. Neither Ako nor Reinfeld remedies this deficiency. For at least this reason, the Graham/Ako/Reinfeld combination fails to teach or disclose each and every element of Applicants' invention as recited in independent claims 1 and 35 and their respective dependent claims. Applicants respectfully request reconsideration and withdrawal of the obviousness rejections based on the Graham/Ako/Reinfeld combination.

**CONCLUSION**

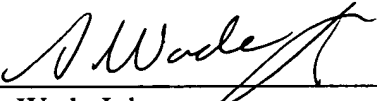
No new matter has been added by any of the amendments and the amendments have not substantively modified the scope of the claims. Consequently, a new search should not be necessitated by the amendments. It is respectfully requested that the amendments be entered by the Examiner.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

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